

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Docket Number (Optional)

RSW920000102US1 (IBM 17)

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on \_\_\_\_\_

Signature \_\_\_\_\_

Typed or printed name \_\_\_\_\_

Application Number

09/758,112

Filed

01/03/2001

First Named Inventor

Touff Boubez

Art Unit

3691

Examiner

HAMILTON, LALITA M

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

/Brian J. Teague/

Signature

☐ assignee of record of the entire interest.  
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.  
(Form PTO/SB/96)

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Typed or printed name

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Registration number if acting under 37 CFR 1.34 \_\_\_\_\_

2011-08-23

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.  
Submit multiple forms if more than one signature is required, see below.

☒ \*Total of 1 forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and assembling the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicant(s): Toufic Boubez et al.	
Application No.: 09/758,112	Conf. No.: 7400
Filed: January 3, 2001	Group Art Unit: 3691
Title: APPARATUS AND METHOD FOR CATEGORIZING SERVICES USING CANONICAL SERVICE DESCRIPTIONS	Examiner: HAMILTON, LALITA M
Attorney Docket No.: RSW920000102US1 (IBM 17)	

Mail Stop AF  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Dear Sir:

In response to the Office Action of July 6, 2011 and in conjunction with the filing of a Pre-Appeal Brief Request For Review and a Notice of Appeal, please consider the following remarks in a pre-appeal brief conference.

### REMARKS

Applicant submits this response to the Office Action mailed July 6, 2011. Claims Claim(s) 1-4, 6-14, 16-24, and 26-30 are rejected under 35 U.S.C. 102(c) as being anticipated by U.S. Patent No. 7,584,120 to Yun. Applicant respectfully traverses this rejection.

It is respectfully submitted that a prima facie case of obviousness does not exist because Yun does not teach or suggest all of the claim limitations found in the independent claims, and thus a prima facie case of anticipation does not exist.

#### Yun Does Not Disclose All Elements of the Claimed Invention

The claims of the present application recite a method, apparatus, and computer program product for registering services. Specifically, independent Claims 1, 11, and 21 recite receiving a registration request for a service. In contrast, Yun discloses a method of creating descriptions of data of interest in order to extract data of interest (Yun Abstract). There is no disclosure in Yun of registering services, or of receiving a request to register a service. In fact, Yun is devoid of any and all variations of the word “register” (e.g., register, registry, registration).

Further, independent Claims 1, 11, and 21 recite receiving a registration request that includes an identified category into which the service is to be registered. Even if Yun could be said to disclose registering services (which Applicant denies), there is no indication in Yun of any possible registration request including an identified category into which the service is to be registered. The Office Action appears to equate Yun’s creation of a description of data of interest (described by Yun at Fig. 3 and Col. 5, line 65 et seq.) with the claimed registration of services. However, Yun’s described creation of a description of data of interest does not include anything about receiving a registration request, nor does it include anything about receiving a registration request that includes an identified category into which the service is to be registered. Rather, Yun merely states that the “author” (presumably of the description of data of interest) decides if the type of information/good/service fits into an existing category (Yun Col. 6, lines 12-20). Again, there is no indication in Yun that any such category information is specified in a registration request.

The Office Action notes that Yun “discloses that the author decides whether a particular type of good or service fits into an existing category or sub-category” and that “[i]f the product

fits into an existing category, then it is added, and if not, then a new category is created” (Office Action, p. 2). Applicant agrees with this description of Yun’s disclosure. However, the Office Action then asserts that such a disclosure proves that “Yun discloses receiving a registration request with an identified category into which the service is to be registered” (Id.). Applicant disagrees with this conclusion drawn by the Office Action, as there is no basis for such a conclusory statement for the reasons stated above.

Yet further, independent Claims 1, 11, and 21 recite determining if the identified category should be used based on a canonical service description associated with the identified category. Again, Yun does not disclose how it is determined which category to use (existing or new), other than to say the “author decides whether a particular type of information, good, or service available at the web site, fits into an existing category, or sub-category” (Yun Col. 6, lines 12-20). If a new category is to be used, Yun does not discuss at all how that new category is determined. Certainly, Yun does not disclose use of a canonical service description for such a determination, as recited in independent Claims 1, 11, and 21.

The Office Action notes that Yun “further discloses that the process can be used for an existing category or adding a new category” and that “[i]f the category is not suitable, another category may be added” (Office Action, p. 3). Applicant agrees with this description of Yun’s disclosure. However, the Office Action then asserts that such a disclosure proves that “Yun discloses determining if the identified category should be used based on a canonical service description associated with the identified category” (Id.). Applicant disagrees with this conclusion drawn by the Office Action, as there is no basis for such a conclusory statement for the reasons stated above.

As Yun does not disclose receiving a registration request with an identified category into which the service is to be registered or disclose determining if the identified category should be used based on a canonical service description associated with the identified category, as recited in independent Claims 1, 11, and 21, independent Claims 1, 11, and 21 are patentably distinct from Yun. Since Claims 2-4 and 6-10 depend from Claim 1, Claims 12-14 and 16-20 depend from Claim 11, and Claims 22-24 and 26-30 depend from Claim 21, the dependent claims are also patentably distinct for at least the reasons described above.

### CONCLUSION

Applicant respectfully submits that all of the claims of the present application are in condition for allowance. It is respectfully requested that a Notice of Allowance be issued in due course. The Examiner is encouraged to contact Applicant's undersigned attorney to resolve any remaining issues in order to expedite allowance of the present application.

It is not believed that extensions of time or fees for net addition of claims are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 CFR § 1.136(a), and any fee required therefore (including fees for net addition of claims) is hereby authorized to be charged to Deposit Account No. 09-0461.

Respectfully submitted,

/Brian J. Teague/

Date: August 23, 2011

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